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| 10/596,127 | 05/31/2006 | Kikue Hayashihara | HAYASHIHARA ET AL-1 PCT | 2612 |
| 25889 | 7590 | 11/19/2008 | EXAMINER | |
| COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576 | | | ABU ALI, SHUANGYI | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Newly submitted claims 2, 6-7, 13-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the liquid clay composition is different from a process of making a liquid clay composition

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2, 6-7, 13-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. It is to be noted that claim 2 has been amended to define a process and claim 6-7, although still directed to a composition, depend on claim 2, thus it is assumed these claimed should actually define a process in the preamble.

Status of Claims

Claims 1, 3, 4-5 remain for examination wherein claims 1, 3, 4-5, are amended, and claims 9-12 are new.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is the equivalent material cited in the claim 3? The phrase "equivalent" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

The rejection of claims 1, 3, 4-5 and 8 under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4,792,357 to Bier as generally set forth in the previous office action mailed 08/18/2008 stands.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4,792,357 to Bier.

Regarding claims 9-12, '212 disclose a paint composition comprising wood powder having a length of less than 0.3 mm, CMC such as 3% CMC solution, PVA, pigment and suitable amount of water et al. But they are silent about the composition comprising alginate as applicant set forth in the instant application. (page 2 and example 1-3).

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However, it would have been obvious to one of ordinary skill in the art to use alginate in the '212' paint composition, motivated by the fact that Bier, also drawn to a paint composition, discloses that water soluble binder such as cellulose, PVA and alginates are used in the paint composition (col. 4, lines 21-40) and it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of CMC and alginate) that is to be used for the same purpose (i.e. as a water soluble binder). In re Kerkhoven 205 USPQ 1069. In addition, all of the above binders are functionally equivalent (i.e. alginate is equivalent to PVA (see Bier)), thus the interchangeability of one functional equivalent material for another is well within the scope of the skilled artisan. In view of this, the interchangeability of PVA defined by the primary reference with alginate is obvious to the skilled artisan, thus the binder of the primary reference would be a mixture of CMC and alginate.

Although '212 is silent about the specific amount of the components used in the composition as applicants set forth in the instant application, it discloses that suitable amount of water is used in the composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicants to vary the water amount to change the components amount in the final composition according to the end use of the composition (page 2 of the translation).

Response to Arguments

Applicant's arguments filed 08/18/2008 have been fully considered but they are not persuasive.

Applicant argues that JP 47046212 does not disclose the information listed by the Examiner in the previous office action. The Examiner respectfully submits that the portion of the paragraphs in the original JP Patent is col. 1, lines 20-25 and col. 2, lines 15-30. The portion of the paragraphs in the English translation document is in page 2 and page 4. As outlined in the previous rejection, all of the claimed limitations are met and applicants show no evidence to the contrary (see full translation of document).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793

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